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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,145

01/14/2004

Randal J. Jolitz

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11/09/2006

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EXAMINER

CHAPMAN, JEANETTE E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/757,145		JOLITZ, RANDAL J.	
	Examiner		Art Unit	
	Chapman E. Jeanette		3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krikhuff (3852934) in view of Gleason et al (4279106). Kirkuff discloses a starter block for facilitating the subsequent positioning of shingles upon a hip roof; the starter block 72 comprising:

1. a top surface 74
2. two side surface
3. a front surface 82 having a rectangular face
4. a back surface 80 having rectangular face
5. the height of the front surface is greater than that of the back surface
6. a shingle 14 placed flat on the top surface 74 will extend back to the roof without bending. See figure 4
7. the width of the starter strip is substantially equal to the width of the shingle, column 8, lines 45-50
8. a nailing zone on the top surface, figure 4
9. the starter block is made of polymer material but does not include a filler commonly used in shingles as shown by Kirkuff, column 6, lines 46-64. It would have been obvious to one of ordinary skill in the art to have the

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starter block made of not only a foam polyurethane but also like the shingle to create a uniform structure to the roof

10. the front surface is shown in figure 3 to be twice the height of the back; the particular dimensions of the starter block/shingle has been considered a matter of choice; one of ordinary skill in the art would have appreciated the dimension of the shingle to be used and would have fashioned the starter block accordingly

11. the top surface resembles a slate

12. a coarse of starter bocks

Kirkuff lacks the tapered side edges. However, tapered side edges is known in the art of shingles as shown by Gleason et al, element 14, figure 3. It would have been obvious to one of ordinary skill in the art to modify Kirkhuff to taper any edge to give a finished appearance to a starter block as shown by Gleason et al..

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkhuff (3852934) in view of Gleason et al (4279106) as applied to claim 1 above, and further in view of Earhardt (5953862).

The nailing zone is not indented as shown by earhardt et al, see abstract. It would have been obvious to one of ordinary skill in the art to modify Kirkhuff to include the indented nailing zone to accommodate proper placement of the nail upon installation of the starter block and shingles.

Claim 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkhuff (3852934) in view of Gleason et al (4279106) as applied to claim 1 above, and further in view of Bussey(2142996).

Kirkhuff lacks the nibs extending from the side surface of the shingle/starter block. Bussey discloses nibs 24/25/26 extending from the side surface of his roofing shingle 27. It would have been obvious to one of ordinary skill in the art to include these nibs on the starter block/shingle of Kirkhoff to provide an aligning means upon installation of the starter block/shingles on the roof.

Claim 12-15 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (2193233) in view of Kirkhuff (3852934) in view of Gleason et al (4279106) further in view of Hudson, Jr. et al (6199338).

Hardy discloses a starter block 11 for facilitating the subsequent positioning of shingles upon a hip roof, the starter block 1 comprising:

- 13. a top surface
- 14. two side surfaces
- 15. a front surface having a rectangular face
- 16. a back surface having rectangular face
- 17. the height of the front surface is greater than that of the back surface
- 18. a shingle 12/13/14 placed flat on the top surface will extend back to the roof without bending. See figure 2

19. the width of the starter strip is not disclosed as being equal to the width of the shingle
20. a nailing zone on the top surface, figure 3
21. the starter block is made of polymer material but does not include a filler commonly used in shingles as shown by Kirkuff, column 6, lines 46-64. It would have been obvious to one of ordinary skill in the art to have the starter block made of not only a foam polyurethane but also like the shingle to create a uniform structure to the roof
22. the front surface is to be twice the height of the back; the particular dimensions of the starter block/shingle has been considered a matter of choice; one of ordinary skill in the art would have appreciated the dimension of the shingle to be used and would have fashioned the starter block accordingly
23. the top surface resembles a slate
24. a course of starter blocks

Hardy shows the tapered side edges. However, the tapered side edges is known in the shingles as shown by Gleason et al, element 14, figure 3. It would have been obvious to one of ordinary skill in the art to modify Hardy to taper any edge to give a finished or different appearance to a starter block as shown by Gleason et al.

Hudson discloses a course of starter shingles of the same length as the shingle. Though Kirkhoff hints at a course of starter blocks, Hudson discloses the course of starter shingles commensurate in dimension with the shingles. It would have been

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obvious to one having ordinary skill in the art to modify Hardy to include a starter shingle commensurate in dimension with the starter shingle in order to facilitate installation as suggested by Hudson and Kirkhoff.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (2193233) in view of Kirkhuff (3852934) in view of Gleason et al (4279106 further in view of Hudson, Jr. et al (6199338) as applied to claim 12 and further in view of Earhardt. The nailing zone is not indented as shown by Earhardt et al, see abstract. It would have been obvious to one of ordinary skill in the art to modify Hardy to include the indented nailing zone to accommodate proper placement of the nail upon installation of the starter block and shingles as shown by Earhardt.

Claim 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (2193233) in view of Kirkhuff (3852934) in view of Gleason et al (4279106 further in view of Hudson, Jr. et al (6199338) as applied to claim 12 and further in view of Bussey. Hardy lacks the nibs from the side surfaces of the shingle/starter block. Bussey discloses nibs 24/25/26 extending from the side surface of his roofing shingle 27. It would have been obvious to one of ordinary skill in the art to include these nibs on the starter block/shingle of Kirkhoff to provide an aligning means upon installation of the starter block/shingles on the roof.

Response to Arguments

Applicant's arguments filed 8/24/06 have been fully considered but they are not persuasive. The three basic criteria have been met. Motivation to combine references is clearly stated above. In response to applicant's argument that there is no suggestion to

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combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Reason expectation of success has been shown such as ease of installation. The prior art suggest the claimed limitation or the limitations are with in the scope of the inventions of the prior art. The prior art teaches the claimed limitations thus the same may be termed a starter block. The secondary references are not bodily incorporated into the teaching of the base references but are cited to show some favorable feature known in the building or roof industry. Again, motivation for combining is given above. What kirkhoff does not have the prior art shows. For example the tapered edges are included to give a finished appearance to the shingle. Another motivation would be to provide for drainage or run off of water. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JEANETTE CHAPMAN
PRIMARY EXAMINER
ART UNIT 3635
